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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,803	12/19/2000	Gary R. McLuen	NEI-00104	7285
28960	7590	10/07/2005		
HAVERSTOCK & OWENS LLP 162 NORTH WOLFE ROAD SUNNYVALE, CA 94086			EXAMINER HANDY, DWAYNE K	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 10/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/742,803	Applicant(s) MCLUEN ET AL.	
	Examiner Dwayne K. Handy	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-30, 35-38, 40, 42 and 44-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-30, 35-38, 40, 42 and 44-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/16/07-7/20/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 27-30, 35-38, 40, 42 and 44-46 are rejected under 35 U.S.C. 102(b) as being anticipated by McGraw et al. (5,368,823). This rejection was previously applied to claims 27-30, 35-38, 40, 42 and 44 and remains in effect. Please see Response to Arguments below.

Response to Arguments

3. Applicant has traversed the rejection of claim 27 under McGraw based on applicant's positional limitation. Applicant has also disagreed with the Examiner's arguments from the Advisory Action mailed 7/14/05. (page 6, line 26 – page 7, line 7 of arguments) on intended use.

In reference to claim 27, the Examiner again reminds applicant that this claim contains intended use language. The phrase "for retaining material within the vial directly above the frit..." is an intended use of the frit. This is not given patentable weight by the Examiner. The Examiner also notes that based on the location of the term "material" in the claim, Applicant has not positively claimed the material as part of the device. A recitation of the intended use of the claimed invention must result in a

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structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). Even if the Examiner were to give weight to the positional limitation, the Examiner believes McGraw still clearly anticipates it. Figure 6 of McGraw shows a vial (11) having a frit (9) with material resting on it. Applicant has also used open claim language – “comprising” – which does not exclude other elements (frit 9A) from being present in the device. This argument also applies to new claims 45 and 46. Applicant has claimed a “single frit” in those claims.

4. Applicant has also argued that McGraw does not meet the limitations of claims 29, 35, and 36. Applicant appears to be arguing that McGraw fails to anticipate the claim because the Luer fitting is not part of the bulkhead (16). The Examiner respectfully disagrees. There is no teaching in McGraw of the Luer fitting being separate from the bulkhead (16). The Examiner refers applicant to column 5, line 41 of McGraw:

In the prototype, the exit basin 17 is a hollowed out portion of a solid frame 17'. The bulkhead 16 is sealed to the top of the solid frame 17' by means of the seal 95 such that the exit basin 17 is not connected to the atmosphere in the reaction chamber 10 except through the Luer fittings 15 which receive the reaction columns 11.

(14) FIG. 6 shows a close-up view of a cylindrically-shaped reaction column 11 used with the prototype of FIG. 2. The column 11 has a conically-shaped outlet end for insertion into a mating Luer fitting 15. The reaction column contains a porous frit 9 with the support 100 placed on the frit 9. A second frit 9A is located over the support 100.

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In addition, Figure 5 shows the Luer fitting (#15 having dotted lines) as extending through the bulkhead 16. Since the bulkhead 16 is the top part of the element the Examiner considers to be a "cartridge", the Examiner believes McGraw clearly teaches a seal between the vial and cartridge.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH
September 30, 2005


Jill Warden
Supervisory Patent Examiner
Technology Center 1700